



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,486	09/29/2005	Marcos Requena Penat	932.1328	4294

21831 7590 05/17/2007
WOLF BLOCK SCHORR AND SOLIS-COHEN LLP
250 PARK AVENUE
NEW YORK, NY 10177

EXAMINER

GANESAN, SUNDHARA M

ART UNIT	PAPER NUMBER
----------	--------------

3764

MAIL DATE	DELIVERY MODE
-----------	---------------

05/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

H

Office Action Summary

Application No.

10/551,486

Applicant(s)

PENAT ET AL.

Examiner

Sundhara M. Ganesan

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/29/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "considerably" is a relative term which renders the claim indefinite. The term "considerably" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. It is unclear what degree of rigidity "considerably" entails.

Additionally, the term "slightly" in this claim is a relative term which renders the claim indefinite. The term "slightly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. It is unclear how much curvature is considered to make a dish-shape.

3. Claim 9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the phrase "the more density" is intended to describe- whether it is the actual material property of density, or the casual use of the

term to refer to the concept of volume. If it is the material property, it is unclear which portion of the inflatable flexible element is being claimed to have "the more density".

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the phrase "is manufactured in" refers to- whether it is a manufacturing process in which the contact platform is coated in a point-elastic material, or whether the contact platform is made of a point-elastic material is unclear.

5. Claim 9 recites the limitation "the base" in line 2. There is insufficient antecedent basis for this limitation in the claim, since a base is not positively recited in this claim or in claim 1, from which this claim depends. This issue can be rectified by either positively reciting "a base" in claim 9, or changing the dependency of the claim (claim 8 is where the base is positively recited).

6. Claim 11 recites the limitation "the base" in line 2. There is insufficient antecedent basis for this limitation in the claim. To rectify this issue, see the suggestion above for claim 9.

7. Claim 16 recites the limitation "said feet" in line 2. There is insufficient antecedent basis for this limitation in the claim. The limitation "said feet" is not positively recited in this claim or claim 1, from which this claim depends. To rectify this issue, "feet" can be positively recited in this claim, or the dependency of the claim can be changed (claim 2 positively recites "feet" and claim 12 depends from claim 2).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-11, and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Piaget et al (US Pat. 5,441,466). Piaget et al. describe the same invention as claimed, including: a double sided support (12) with one upper and one lower side, one of which is considerably rigid and the other includes an inflatable flexible element (14B), resting means (the floor, not pictured) for the support that allow users to carry out aerobic and cardio exercises and to work on their physical condition in general using the rigid side, wherein the inflatable element is slightly dished (the inflatable element (14B) has a slightly curved profile). The device taught by Piaget is inherently capable of allowing users to work on both areas of aerobic and cardio and the areas of balance, proprioception, and coordination.

Regarding claim 3, Piaget et al. show the inflatable flexible element as being detachable and joined to the support by joining means ((38), see Fig. 2).

Regarding claim 4, Piaget et al. show the considerably rigid side as comprising a contact platform (24) joined to the support by joining means (Col. 2, lines 60-62 shows that the contact platform and the device are not integrally formed, therefore there must

be some joining means connecting the two. Most likely it is an adhesive joining means or a rubberized spray coating).

Regarding claim 5, Piaget et al. show the joining means as comprising a housing (40) which accommodates the inflatable flexible element (see Fig. 4).

Regarding claim 6, the housing comprises means to set the position of the inflatable flexible element. The joining means (38) set the position of the inflatable flexible element.

Regarding claim 7, the inflatable flexible element comprises means (32) to set its position in the housing.

Regarding claim 8, Piaget et al. show the flexible element as having a rectangular base in Fig. 9.

Regarding claim 9, Piaget et al. show the inflatable flexible element as comprising the thickest area of the base (see Fig. 9).

Regarding claim 10, Piaget et al. show the flexible element as comprising supports (28) on its base.

Regarding claim 11, Piaget et al. show the inflatable flexible element as comprising a platform joined to the base (platform (12) is joined to the base of the inflatable flexible element).

Regarding claim 13, the support comprises means (26) to fix elastic bands. The gap and supporting structure formed by the handles (26) is sufficient for fixing and elastic band, and the device is inherently capable of supporting such elastic bands for exercises entailing toning up muscles, body building, and rehabilitation.

Regarding claim 15, Piaget et al. show the device comprising means to regulate its height (Col. 1, lines 46-50).

Regarding claim 16, Piaget et al. show the support comprises means (26) to hold and handle the device (col. 2, lines 63-65).

Regarding claim 17, Piaget et al. show the inflatable flexible element as comprising means to hold and handle it. The sides or base of the inflatable flexible element is sufficient for gripping by a user to hold and handle the device.

Regarding claim 18, Piaget et al. show the flexible element comprising at least one valve (46) to modify the pressure inside it.

10. Claims 1-2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chuang (US Pat. 5,765,921). Chuang describes the same invention as claimed, including: a double sided support (51) with one upper and one lower side, one of which is considerably rigid and the other includes an inflatable flexible element (4), resting means (11,12) for the support that allow users to carry out aerobic (in this case, stepping) and cardio exercises and to work on their physical condition in general using the considerably rigid side (the user steps on this portion), wherein the inflatable flexible element is slightly dished (see Fig. 1) and allows users to carry out balance, proprioception and coordination exercises when standing on it.

Regarding claim 2, Chuang shows that the resting means are feet (11, 12) that rotate around the support and around a considerably horizontal axis.

Regarding claim 12, Chuang shows the support as comprising gaps (23) to partially scramble the feet.

11. Claims 1, 4 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallaro (US Pat. 4,516,768). Gallaro describes the same invention as claimed, including: a double sided support (76) with one upper side and one lower side, one of which is considerably rigid, and the other includes an inflatable flexible element (16), resting means (84) for the support that allow users to carry out exercises; the inflatable element being slightly dished (see Fig. 1) and allows users to carry out balance, proprioception and coordination exercises when standing on it.

Regarding claim 4, Gallaro describes the considerably rigid side as comprising a contact platform (62, 64) joined to the support by joining means (adhesive, described in Col. 4, lines 63-64).

Regarding claim 14, Gallaro describes the contact platform as being manufactured in a point-elastic material that is capable of absorbing and restoring energy. In Col. 4, lines 50-53, Gallaro describes "A soft cushion material...formed of rubber or plastic material". A rubber material as described by Gallaro would provide the point-elastic material capable of absorbing and restoring energy as required by this claim.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See form PTO-892 for cited art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sundhara M. Ganesan whose telephone number is 571-272-3340. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cary O'Connor can be reached on (571) 272-4715. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.G.
05/10/2007


LORI AMERSON
PRIMARY EXAMINER